

REMARKS

Claims 15-17 are pending. By this Amendment claim 17 is amended and no new claims are added.

Claim Rejections Under 35 U.S.C. § 112

Claim 17 is rejected under 35 U.S.C. 112 as failing to comply with the written description requirement. The reference to a resource identified by a telephone number has been deleted and it is respectfully requested that the rejection be withdrawn.

Claim Rejections Based on the Brooks Presentation

Claims 15 and 16 are rejected under 35 U.S.C. 102(a) as being anticipated by the presentation by Paul W. Brooks entitled “Internet Assessment: Opportunities and Challenges.” Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the presentation by Paul W. Brooks entitled “Internet Assessment: Opportunities and Challenges” in further view of Ogden, U.S. Pat. No. 6,311,164. These rejections are respectfully traversed.

As asserted by the Applicant in the attached §1.132 affidavit by the inventor, Katrina Dewar, accompanying this amendment, Paul W. Brooks prepared and delivered the referenced presentation as part of his work for and under the direction of the corporation, ePredix, Inc., which the Applicant founded and was the Chief Executive Officer at the relevant time. The Dewar affidavit properly establishes a basis for swearing behind the Brooks presentation as this material actually was derived from the inventor of the present application and does not represent a prior invention by another. In terms of interrogatory 2) set forth in the Office Action, Paul Brooks is not an inventor of the present application for the reasons set forth in the Dewar affidavit.

In terms of interrogatories 1) and 3) set forth in the Office Action, the attached §1.132 affidavit by Christine Arrell, counsel for PreVisor, Inc., the successor in interest to ePredix, Inc., and Brad Pedersen under signed attorney for Applicant, sets forth the answers in terms of any potential relevant publications dated prior to June 11, 2000 by either ePredix or the inventor.

Accordingly, Applicant respectfully that the 102(a) rejections based on the Brooks presentation should be withdrawn.

Claim Rejections Based on the "StoreWorks" Document

Claims 15 and 16 were rejected as being anticipated under 35 U.S.C. 102(b) by Decision Point Data, Inc. "1999 StoreWorks! Conference and Exhibition," hereinafter "the StoreWorks Document." Claim 17 was rejected under 35 U.S.C. 103(a) as being unpatentable over the StoreWorks Document in further view of Ogden U.S. 6,311,164. These rejections are respectfully traversed.

The StoreWorks document lacks a publication date. While it does contain the number 1999 in the title, there is no disclosure of how or when the StoreWorks document was made available to the public. The Applicant's attorney has attempted to independently locate an original copy of the document, but was only able to find a reference to it in U.S. Patent 7,080,057 to Scarborough et. al. which was published on July 18, 2006 and is assigned to Unicru, Inc. The StoreWorks document was submitted in an IDS filed during the prosecution of the '057 patent application on September 23, 2005. As stated in the Other Publications section of the '057 patent, Decision Point Data, Inc. is a predecessor company of Unicru, Inc., the assignee of the '057 patent. Absent any other information, the record suggests that the first public disclosure of the StoreWorks document was made by Unicru, Inc. during the prosecution of the '057 patent, as the successor to the Decision Point Data, Inc. organization that authored the StoreWorks document. Therefore, the Applicant respectfully asserts that unless evidence is available to the

contrary, the earliest publication date for the StoreWorks document that is presently of record is sometime after September 23, 2005 and as such it does not satisfy the one-year time requirement of 35 U.S.C. 102(b).

Assuming *arguendo* that the StoreWorks document was created sometime prior to September 23, 2005, and posted on the Internet or otherwise publicly posted, the reference cannot be relied upon as prior art. MPEP § 2128 states that disclosures on the Internet do qualify as publicly available publications. However, “[a]bsent evidence of the date that the disclosure was publicly posted, if the publication itself does not include a publication date (or retrieval date), it cannot be relied up as prior art under 35 U.S.C. 102(a) or (b).” *Id.* The StoreWorks document appears to be some form of slideshow presentation, presumably created with electronic software. This does not appear to be self-authenticating document and the Office Action has not established a *prima facie* case of publication prior to June 12, 1999.

Even if the StoreWorks document were proper prior art, which it is not, the Applicant asserts that the StoreWorks document fails to fully disclose, describe, or enable the claimed invention as required under §102(b) for a document to serve as prior art. The Office Action attempts to broadly paint the StoreWorks document onto claim 15 of the present application. The “Profiling System” bullet point on page 3 of the StoreWorks document only discloses a system for constructing a standardized question and reporting system. It does not disclose “a set of validated questions validated by correlating job performance ratings of a plurality of hired workers with previous responses give by the workers to the application questions before the workers were hired.” The Office Action asserts that the StoreWorks document discloses the process of correlating the answers of applicants with current workers whose performance is known by citing a bullet point on page 2 which only discusses standardizing questions asked across a company to achieve compliance. Standardizing questions across a company does not

teach or suggest preparing a set of validated questions that are statistically validated to correlate job performance ratings with previous responses.

The Office Action cites MEPE 2111.04[R-3] for the proposition that “no patentable weight is given to the intended result.” However, the full language of MPEP 2111.04[R-3] addresses “adapted to,” “adapted for,” “wherein,” and “whereby” clauses. None of these clauses are present in claim 15. The quote from *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, is related to the intended result addresses method claims. Claim 15 is a system claim. The Applicant respectfully asserts that MPEP 2111.04[R-3] is not applicable in this case and that the StoreWorks document lacks a “set of validated questions being a short subset of a large assessment.” Without the claim element of taking a set of validated questions that can be used as a fast job-related pre-screen the StoreWorks document can not anticipate the claimed invention.

The Applicant has focused this Response to the Office Action on those specific elements of the instant claims that are most clearly lacking in the StoreWorks document. The lack of response to each and every element of the StoreWorks document that the Office Action argues reads onto the claimed invention should not be interpreted as an admission that those elements that were not addressed are anticipated by the StoreWorks document.

Claim 17 has been amended to focus on resources that are identified by a uniform resource locator as disclosed in the specification. The Applicant therefore respectfully asserts that the objection to claim 17 under §103(a) has been traversed for the reasons set forth above.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'BRAD D. PEDERSEN', followed by a long horizontal line.

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